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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,837	12/01/2003	Tony Reid	017622-000130US	3216
20350	7590	10/04/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			THANH, QUANG D	
			ART UNIT	PAPER NUMBER
			3764	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/725,837
Filing Date: December 01, 2003
Appellant(s): REID, TONY

MAILED

OCT 04 2005
Group 3700

Joel M. Harris
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/26/2005 appealing from the Office action mailed 01/05/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because independent claim 1 does not include "At least the first sleeve can have a very low coefficient of friction and at least the second sleeve can consist essentially of thin fabric sleeves" as stated by the appellant.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5171211	DEASY, Jr.	12-1992
814795	MYERS	03-1906

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deasy, Jr. (5,171,211) in view of Myers (814,795).

Re claims 1, 5 and 10, Deasy discloses a system for applying pressure to a body limb, said system comprising: a first sleeve 18 configured to be slid over entire length of the arm from the shoulder to the wrist (fig. 7) and to apply an inward pressure onto the limb; a second sleeve 46 configured to be slid over *substantially* the entire

length of the first sleeve (best seen in fig. 7) and to apply additional inward pressure along the length of the limb (col. 4, lines 35-45); except it is silent regarding the first sleeve having foam lining with ridges formed over an inner surface. However, Myers teaches a system for applying pressure ("compressive covering" disclosed on line 9) to a body limb, said system comprising: a first innermost therapeutic pressure sleeve 1 (TPS) having a foam lining with ridges 3 formed over an inner surface, configured to be slid over the limb (figs. 1 and 3) and to apply an inward pressure onto the limb; a second sleeve 4 configured to be slid over the first sleeve and to apply additional inward pressure onto the limb; and a third sleeve 4 ("4 represents a series of outer encircling bands" as disclosed on lines 42-46) configured to be slid over the second sleeve and to apply additional inward pressure onto said limb (fig. 1 shows an inner sleeve 1 and two outer sleeves 4). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deasy, to include foam material for lining the inner surface of the first sleeve for the purpose of providing comfortable cushioning for the wearer during use, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and also specifically to include a foam lining with ridges formed over an inner surface, as taught and suggested by Myers, for the purpose of increasing the effectiveness of the compression therapy in the treatment of edema and providing improved the user's stamina (Deasy, col. 4, lines 60-66).

Re claims 2 and 6, Deasy discloses that the sleeve may be made of flexible relative heavy and strong elastic material (col. 3, lines 30-40), and therefore it would have been obvious to one having ordinary skill in the art at the time the invention was

made, to select a flexible material that also has a low friction characteristic to assist in removing the sleeve, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Re claims 4 and 9, Deasy taught that "each component part or portion of the garment is made of elastic material and is sized so as to be compressive on the body of the user" (col. 3, lines 46-48) for the purpose of reducing the symptoms of edema (col. 4, lines 65-66), and therefore depending on the size of the user and the limb the device is placed on, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to configure the Deasy' sleeve such that it would be capable of providing a wide range of radially inward pressure, including slight pressure or greater pressure in the range of 5 mmHg to 30mmHg.

Re claim 7, Myers further teaches a third sleeve 4 ("4 represents a series of outer encircling bands" as disclosed on lines 42-46) configured to be slid over the second sleeve and to apply additional inward pressure onto the limb (fig.1 shows an inner sleeve 1 and two outer sleeves 4).

Re claims 3 and 8, Myers' second and third sleeves 4 appear to be thin bands (fig. 1) and therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made, to select a flexible fabric material to make these outer sleeves, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

(10) Response to Argument

In response to the Appellant's argument re claims 1 and 5 that "In Deasy, regardless of which sleeve is considered first or the second, neither sleeve is adapted to be placed 'over substantially the entire length of the other sleeve in order to apply pressure 'along the length of the limb.'", since the claim language requires "substantially", which is defined by Merriam-Webster's dictionary as "being largely but not wholly", therefore as broadly recited, Deasy's sleeve 46 configured to be slid over the sleeve 18 in fig. 7 appears to comprehend the claimed language. With respect to Appellant's argument that "In the case the arm sleeves, Deasy shows such overlap only at the elbow", the examiner respectfully disagrees and maintains that figure 7 of Deasy clearly shows an overlap not only at the elbow, but also above the elbow at the arm and below the elbow at the forearm. This overlap clearly shows sleeve 46 configured to be slid over **substantially** (being largely but not wholly) the entire length of sleeve 18.

In response to the Appellant's argument that "Nor does Deasy recognize that it is desirable for inner and outer sleeves to combine the inward pressure they place on the limb. Instead, use of the separate arm and leg component seems to be a convenient way of allowing the user to put on and take off the suit, not in any way intended to enhance the treatment or increase pressure", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Moreover, a recitation

of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case, Deasy teaches that “the elastic garment includes six component parts which can be worn in various combinations depending upon the intended use” (col. 3, lines 30-43) and since both sleeves of Deasy’s garment are made from an elastic material (col. 3, lines 30-43), therefore any one of the sleeves is capable of applying inward pressure, and the overlap of the two sleeves at a particular part of the user would provide a stronger combined compressive therapy than just one sleeve alone.

In response to Appellant’s argument that “the function of the Myers bandage is likened to a tourniquet”, the examiner respectfully disagrees. Myer’s lines 42-46 teaches that “a series of outer encircling bands 4, which may either be integral or **separately** applied in order to give **greater compression** than the bandage **alone** at any desired point”, thus the bandage (or sleeve 1, fig. 1) can be used alone. The encircle bands 4 “may apply localized compression, as of a tourniquet” (lines 63-64), but the band does not cut off the blood circulation as a true tourniquet does, instead the band is used to provide additional greater compression at any desired point as discussed above.

In response to Appellant’s argument that “the combination of Deasy and Myers does indeed teach away from the claimed invention” and that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Deasy teaches an elastic sleeve that provides compression therapy to a limb with additional pressure point application at enlarged beads 58 (fig. 7). Myers teaches a sleeve 1 having a foam lining to provide compression therapy with additional pressure point applicators at irregular (ridges) inner surface 3 (fig. 5). Myers also teaches additional pressure applicators 4 on the outer surface of the foam sleeve 1 (fig. 1) to provide added pressure. Therefore, the combination of Deasy and Myers does not teach away from the claimed invention, but instead combining Myers with Deasy would increase the effectiveness of the compression therapy by using the increased number of pressure points with the irregular (ridges) inner surface, taught by Myers, plus the overall elastic compression provided by the sleeve of Deasy including the additional pressure point applicators provided by enlarged beads 58. Furthermore, Deasy already teaches the elastic garment can be used effectively in treating edema and other conditions such as varicose veins or the like (col. 2, lines 56-63), in which the garment compresses the veins and/or arteries thereby effecting the flow of blood through the veins and arteries. Myers is cited to teach a similar elastic sleeve that is desirable to provide concentrated compression along a vein or artery (lines 50-54), and specifically to teach a foam lining having a series of irregular inner surface in the form of ridges.

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Therefore, it appears that there is no unobviousness for one having ordinary skill in the art at the time the invention was made, to combine both references such that the Deasy's inner sleeve would have a foam lining with ridges formed over an inner surface, as taught and suggested by Myers, for the purpose of providing additional concentrated compression to a desired body portion thus reducing edema or varicose vein in the portion.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

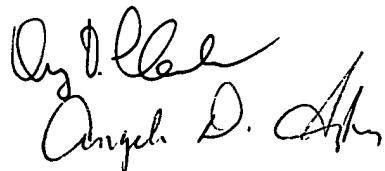
Respectfully submitted,

qt

September 22, 2005

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